



17 NOV 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

CALFEE HALTER & GRISWOLD, LLP
800 SUPERIOR AVENUE
SUITE 1400
CLEVELAND OH 44114

In re Application of:

ROYCROFT, Terrence, James	:	DECISION ON PETITION UNDER
U.S. Application No.: 10/533,334	:	37 CFR 1.47(b)
PCT No.: PCT/GB2003/004752	:	
International Filing Date: 01 November 2003	:	
Priority Date: 01 November 2002	:	
Attorney's Docket No.: 30451/04013	:	
For: AMPHIBIOUS VEHICLE WHEEL	:	
TRANSMISSION ARRANGEMENT	:	

This decision is issued in response to the "Petition Under 37 CFR 1.47(b)" filed 10 October 2006. Petitioner submitted \$130 as the petition fee; however, the applicable petition fee is \$200. Deposit Account No. 03-0172 will be charged the additional \$70 required to complete the petition fee.

BACKGROUND

On 01 November 2003, applicant filed international application PCT/GB2003/004752. The application claimed a priority date of 01 November 2002, and it designated the United States. On 13 May 2004, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 02 May 2005 (01 May 2005 was a Sunday).

On 02 May 2005, petitioner filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 06 April 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an executed oath or declaration acceptable under 37 CFR 1.497 and the surcharge for filing the declaration later than thirty months after the priority date were required.

On 10 October 2006, petitioner filed a response to the Notification Of Missing Requirements (with required four-month extension fee). The response included payment of the \$65 small entity surcharge for filing the declaration later than thirty months after priority date, and the petition considered herein. The petition seeks acceptance of the application without the

signature of the sole inventor, whom petitioner states has refused to execute the application papers.

DISCUSSION

A grantable petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The present petition satisfies items (1), (3), and (6).

Regarding item (1), petitioner has Petitioner submitted \$130 for the petition fee. Deposit Account No. 03-0172 will be charged the additional \$70 required to complete the petition fee. Item (1) is therefore satisfied.

Regarding item (2), where it is asserted that the inventor has refused to execute the application papers, section 409.03(d) of the MPEP states that a “copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.” The MPEP also requires “a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made.” Here, petitioner has provided a declaration by Michael J. Giles, with accompanying exhibits. The exhibits include email correspondence from the non-signing inventor in which the inventor confirms that he has received a declaration and assignment form, and in which the inventor demands payment from the assignee before he will sign such documents. However, the petition does not provide a firsthand showing that a copy of the complete application papers (including description, claims, and drawings), accompanied by a request for signature, has been mailed to the non-signing inventor at his last known address, as required (the petition refers only to the declaration and assignment). Before item (2) can be considered satisfied, petitioner must provide firsthand evidence (with documentary support) confirming that a copy of the complete application papers, with a request for signature, has been mailed to the inventor at his last known address, and that the inventor has refused to provide the required signature. Based on the above, the present record does not satisfy item (2).

Regarding item (3), the petition includes an express statement of the last known address of the nonsigning inventor. Item (3) is satisfied.

Regarding item (4), the petition states that it includes an “executed Declaration under 37 CFR 1.64 consisting of Declaration presented to Inventor and added page executed by Assignees.” However, no such document is present in the application file. Item (4) is therefore not satisfied on the present record.

Regarding item (5), section 409.03(f) of the MPEP states the following:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that: (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

Petitioner here asserts that it has the required proprietary interest based on an assignment document executed by the non-signing inventor, a copy of which is included with the present petition. However, the MPEP states that, in such cases “[t]he assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant.” Here, the assignment document lists numerous inventions, none of which on their face clearly correspond to the present application, and it was executed on 21 December 2000, nearly two years prior to the filing of the priority application claimed herein. Under these circumstances, it cannot be concluded that the assignment supplied by petitioner here clearly pertains to the invention described in the present application. Accordingly, the present submission does not adequately demonstrate the required proprietary interest of the 37 CFR 1.47(b) applicant. Item (5) is therefore not satisfied on the present record.¹

Regarding item (6), the petition includes the required statement that granting of the present petition is necessary to preserve the rights of the 37 CFR 1.47(b) applicant. Item (6) is satisfied.

Based on the above, petitioner has failed to satisfy all the requirements for a grantable petition.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled “Renewed Petition Under 37 CFR 1.47(b)” and must include the materials required to satisfy items (2), (4), and (5) of a grantable petition, as discussed above and in the applicable sections of the MPEP.

Failure to provide a proper and timely response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

¹ See MPEP section 409.03(f) for the specific requirements for demonstrating a proprietary interest where the inventor has agreed to assign the invention, where the 37 CFR 1.47(b) applicant “otherwise has sufficient proprietary interest in the subject matter.”

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273- 0459